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|--|----------------------------|--------------------------------------|----------------------------------|---------------------------|-------------------------------------|--|------------------|----------------------------|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 112-1001 | | | | | | |
| <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p> | | | | | | | | |
| <table border="1"> <tr> <td>Application Number 09/685,138</td> <td>Filed October 11, 2000</td> </tr> <tr> <td colspan="2">First Named Inventor Ju-Heon LEE</td> </tr> <tr> <td>Art Unit 2182</td> <td>Examiner Tanh Q. Nguyen</td> </tr> </table> | | | Application Number 09/685,138 | Filed October 11, 2000 | First Named Inventor Ju-Heon LEE | | Art Unit 2182 | Examiner Tanh Q. Nguyen |
| Application Number 09/685,138 | Filed October 11, 2000 | | | | | | | |
| First Named Inventor Ju-Heon LEE | | | | | | | | |
| Art Unit 2182 | Examiner Tanh Q. Nguyen | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> | | | | | | | | |
| <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>53,868</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> | | | | | | | | |
|  Signature David R. Wood Typed or printed name 202-775-1900 Telephone number August 3, 2007 Date | | | | | | | | |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | | | | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS/ARGUMENTS

The Examiner has issued an Advisory Action dated June 12, 2007 in which entry was denied to an Amendment after Final filed on June 4, 2007. The finality of the Office Action of April 15, 2007, should have been withdrawn given the Examiner's improper reliance on the Liu reference, as was fully discussed in the Applicant's most recent response of June 4, 2007, but was apparently ignored by the Examiner. Nevertheless, this Advisory Action follows multiple Office Actions asserting the same rejections of the claims in this Application. Despite multiple attempts¹ by Applicant's representatives to convince the Examiner that there lacks motivation to combine references and that the Examiner is engaging in improper hindsight reconstruction based on non-analogous art, the Examiner continues to reassert rejections under 35 U.S.C. §103(a), which are improper for at least the following reasons:

1. Deficiencies of the primarily-cited MachASP reference that are allegedly overcome by secondarily-cited Liu reference are simple not disclosed, taught, or suggested in the English portions of Liu.
2. The sliding power connector cover allegedly disclosed in Liu is drawn from non-analogous art and can only be applied to MachASP through hindsight reconstruction.
3. The Examiner's reasoning includes qualifications that rule out correct interpretation of the full combination of the claim recitations.

I. Sliding cover allegedly taught by Liu is not described in the English portions thereof

The Examiner maintains the position that the MachASP reference fails to disclose a connector cover capable of sliding backwards upon insertion of the portable memory device, and that Liu allegedly teaches "an electrical plug having ... a connector cover capable of sliding automatically backwards upon insertion of the electrical plug into an electrical socket and exposing the electrical connector." See Office Action dated October 18, 2006, page 5, lines 1-4, and final Office Action dated April 5, 2007, page 3, item 5. The Examiner further maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the connector cover allegedly in Liu "sliding automatically backward upon insertion

¹ Including the personal interview with the Examiner on February 27, 2007

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of the portable memory device into the USB port" into MachASP "in order to protect the USB connector." See Office Action dated October 18, 2006, page 5, lines 5-9, and the final Office Action dated April 15, 2007, page 3, lines 15-18.

The Examiner's application of Liu is made by extrapolating unqualified elements allegedly therein so as to fit the recitations of the pending claims of the subject Patent Application. However, the features allegedly taught by Liu are not gleaned from its English Abstract and drawings. Indeed, nowhere in either the Abstract or the drawings is there an indication that a sliding cover even exists in Liu's electrical plug. Quite to the contrary, the drawings appear to show rigidity in the regions where sliding members would be necessary to enable the cover in Liu to slide at all, much less in a manner consistent with the recitations of the pending claims. The English portions of Liu completely lack any description regarding its operation, and, as such, its pertinence to the claims of the subject Patent Application cannot be ascertained. Given such lack of description, Applicant is precluded from using disclosure in Liu that might teach away from its combination with MachASP, which is, at least in part, the rationale behind the guidelines for rejecting claims using foreign abstracts established in the M.P.E.P §706.02 (II).

II. Sliding electrical safety cover on electrical power plugs is non-analogous art

In addition to the evidentiary shortcomings of Liu, but ignoring them for the sake of further discussion, Applicant has maintained an objection to the application of Liu on the grounds that it is non-analogous art, and, as such, can only be applied through impermissible hindsight reconstruction. A slideable cover for a large power connector attached to an unwieldy cable, and for which the cover is intended to prevent electrical shock, leaving aside for the moment whether such is in fact disclosed by Liu, would not be a field where an ordinarily skilled artisan in the USB portable memory art, or even in the electrical and mechanical arts in general, would seek a solution for protecting a low voltage signal connector from damage caused from being carried in a pocket or the like. The Abstract of Liu and the disclosures of other references² directed to power connectors cited by the Examiner, name electrical shock prevention as a primary objective. The cover on such power connectors may coincidentally shield the connector from accidental damage in fulfilling its primary objective of safety, but any

² Such as the Powell reference

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damage to the power connector would not be incurred through contact with items in a person's pocket or the like, which is the problem solved by Applicant's inventive combination. As such, a cover on a power connector, even if it prevents damage incidentally, does not address the problem confronting Applicant at the time of the subject invention.

When properly "cast[ing] the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art³," an ordinarily skilled artisan confronted with the task of protecting a small structure that may be readily transported, such as within one's pocket or as a fob on a key-ring, and is to remain clean and undamaged through varying environments so that secure access to a computer can be obtained, would not have had the spark of invention when being presented Liu. Indeed, it is unlikely that one would even recognize a solution from pondering Liu, or any other power connector reference, since such art depicts much larger structures that could not possibly be carried in one's pocket, due to its size, for example, and would operate well in practically any environment, even when dirty. Thus, Applicant vigorously maintains that the Examiner's combination of MachASP, or any other alleged USB memory device, and Liu, or any other alleged covered power connector, could only have come from conclusions derived while in cognitive possession of Applicant's disclosure at the time the references were discovered, which is the very definition of hindsight reconstruction.

The Examiner has continuously presented the rationale that any judgment on obviousness is in a sense hindsight reconstruction. Indeed, that is precisely why great care must be taken to prevent unwittingly fitting a reference to the claims while in possession of the solution already obtained from Applicant's disclosure. It is respectfully submitted that regardless of any innovations made in the power connector art at the time the subject invention was made, Applicant devised a novel solution to a problem not found elsewhere in the electrical connector art.

³ W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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III. The full combination of recited features not considered

The Examiner has also maintained that Miller discloses "determining if a USB device 40 is connected to the computer (110), (if security is enabled) ... and enable the hard disk drive (after the password entered by the user is verified)...". The Examiner is thus adding qualifiers to the recitations of the claims so as to fit Miller thereto, but in the process disregards the recitations of the subject claim that do not allow such a fit. For example, the Examiner has failed to address how Miller discloses, teaches or suggests, "booting up the host computer only when the USB security device is attached to the USB port of the host and only when the password stored in the USB security device matches the password stored in the host computer" (emphases added), as recited in, for example, independent claim 25. Miller nowhere discloses such a protective feature and, in fact, teaches away from such. For example, if a computer operates in accordance with Miller's teachings, and that computer does not have a USB, thereby precluding an ability to "boot[] up the host computer only when the USB security device is attached," the computer in Miller is allowed to boot normally. See Miller, column 4, lines 37-38 and FIG. 6.

In paragraph 10 of the final Official Action of April 15, 2007, the Examiner states, "[p]lease note that connecting a device prior to power up, booting the host comprising loading an operating system are inherent during the power up and booting of the computer," and, "[p]lease further note that the claim does not exclude the presence of the step of checking for the enablement of the security and matching of user's password." These statements are further evidence that the Examiner is attempting to make the reference fit to the claim recitations, which is improper. Notwithstanding the Examiner's assertions that the claim recitations do not preclude "checking for the enablement of the security," the operations of "booting up the host computer only when the USB security device is attached to the USB port of the host and only when the password stored in the USB security device matches the password stored in the host computer," as recited in the claims, renders such checking superfluous. The Examiner's further allegation that plugging in a device prior to power up is an inherent feature is immaterial when such plugging is intended to bring about other operations recited in the claims, but that are not disclosed, taught or suggested in Miller.

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IV. Conclusion

It is respectfully submitted, therefore, that the pending claims of the subject Patent Application, when properly interpreted to the broadest possible scope and evaluated against valid prior art, is novel and non-obvious over the valid prior art cited by the Examiner. Accordingly, allowance of the pending claims is earnestly solicited.

Respectfully submitted,

STANZIONE & KIM, LLP

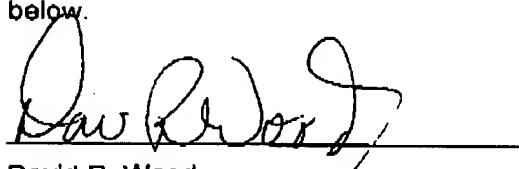
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